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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,965	12/15/2003	Fernando Salazar	LOT920030070US1 (024)	1335
46321 7590 12/12/2008 CAREY, RODRIGUEZ, GREENBERG & PAUL, LLP STEVEN M. GREENBERG 950 PENINSULA CORPORATE CIRCLE SUITE 3020 BOCA RATON, FL 33487				
EXAMINER				
TO, BAOQUOC N				
ART UNIT		PAPER NUMBER		
2162				
MAIL DATE		DELIVERY MODE		
12/12/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/734,965

Applicant(s)

SALAZAR ET AL.

Examiner

BAOQUOC N. TO

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4,5,7-9,12,13,15-17,20,21,23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,7-9,12,13,15-17,20,21,23 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In view of the Appeal Brief filed on 01/28/2008, PROSECUTION IS HEREBY REOPENED. As the reason set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/John Breene/

Supervisory Patent Examiner, Art Unit 2162

2. Claims 1, 4-5, 7-9, 12-13, 15-17, 20-21 and 23-24 are pending in this application.

Response to Arguments

3. Applicant's arguments filed on 09/29/2008 have been fully considered but they are not persuasive.

The rejection of claims 17, 20-21 and 23-24 under 35 U.S.C 101 (For Non-statutory subject matter).

Applicant argues "a discussion of the procedure consideration regarding a rejection based upon lack of utility (i.e., 35 U.S.C 101) is found in M.P.E.P 2107.02. Specifically, M.P.E.P 2107.02(1) states that:

regardless of the category of invention that is claimed (e.g., product or process), an applicant need only make one credible assertion of the specific utility for the claimed invention to satisfy 35 U.S.C 101 and 35 U.S.C 112

In paragraph [0009] of Appellants' disclosure, it is stated...

Since a credible utility is contained in the Appellants' specification, the utility requirement 35 U.S.C 101 (i.e., whether the invention produces a useful, concrete, and tangible result) has been met. Moreover, Therefore, Appellants respectfully assert that the examiner erred."

The examiner disagrees with the above argument. While it is truth that M.P.E.P 2107.02(1) state that regardless of the category of invention that is claimed (e.g., product or process), an applicant need only make one credible assertion of specific utility for the claimed invention to satisfy 35 U.S.C 101 and 35 U.S.C 112; however, in paragraph 0009 does not show the transformation underlying subject matter (such as an article or materials) to a different state or thing. Claim and the specification do not transform such article or material to a different state or thing. And there is no utility in

either the claim or applicant specification, the invention does not produce a useful, concrete and tangible result. ((*Diamond v. Diehr*, 450 U.S. 175, *Parker v. Flook*, 437 U.S. 584, *Gottschalk v. Benson*, 409 U.S. 63 and *Cochrane v. Deener*, 94 U.S. 780).

Furthermore, claim 17 recites " a data transformation tool..., tool comprising: a data transformation utility adapted to convert..., a data matching utility adapted to determine..., and data loading utility adapted to load... " is software or a program per se. Software per se is not a series of steps or acts and thus is not a process. Software per se is not a physical article or object and as such is not a machine or manufacture. Software per se is not a combination of substances and therefore is not a composition of matter

The rejection of claims 1, 4-5, 9, 12-13, 17 and 20-21 under 35 U.S.C. 103(a) for obviousness based upon Martin in view of Prompt and further in view of Whitehurst.

Claims 4-5 and 7-8 stand or fall together with claim 1, claims 12-13 and 15-16 stand or fall together with claim 9, and claims 20-21 and 23 stand or fall together with claim 17.

Applicant argues martin fails to teach or even mention a "learning process" or "LMS" or "user information" or "course information" or an "e-learning model"...."

Examiner provided Martin which discloses a data transformation from a source database to a target database. The data such as "learning process" or "LMS" or "user information" or "course information" or an (e-learning model)" are just data which were disclosed by Martin.

Applicant argues "inexplicitly, after admitting that Martin does NOT teach or mention an e-learning model to a target database in a learning management system, the Examiner refers to the Prompt reference which also does NOT or mention a-learning model to a target database in a learning management system. Accordingly, the Prompt reference fails to cure the failures of Martin...."

Examiner provides Prompt reference to further explain a data transformation including matching object form one object from one directory to another object to another directory. According to applicant above argument, Prompt does not include an "e-learning model" and/or a "learning management system" and/or "user information" and/or "course information"; however, as explained above "e-learning model" and/or a "learning management system" and/or "user information" and/or "course information" are just data which can be the data being converted to the target database.

Applicant also "in a failed attempt to correct the error, the Examiner refers to the Whitehurst reference for the proposition of "learning strategies". Whitehurst discloses a learning method and system that assess a learner's understanding of the subject matter and... Significantly, Whitehurst does not address a conversion of learning data, i.e., "user information and course information". The examiner has engaged in the "impermissible hindsight" that the Supreme Court has consistently cautioned that the fact finder to avoid..."

Examiner provides Whitehurst to provide data as user information and course information and these data can be used to transform the data from a source database to a target database within the Martin and Prompt. The examiner disagrees with the

applicant argument regarding to "impermissible hindsight" because the recent court case the construction of one or more references are permissible as long as the construction by one ordinary skill in the art would yield a expectable result. Moreover, in view of the guidance provided by the Supreme Court in *KSR* decision, the patent claim is prima facie obvious if "some motivation or suggestion to combine the prior art teachings" can be found in the prior art, the nature of the problem, or the knowledge of a person having ordinary skill in the art. See the recent Board decision *EX parte Smith*, -- USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007 (citing *KSR*, 82 USPQ2d at 1396) (available at <http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071925.pdf>)).

The rejection of claims 8, 15, and 23 under 35 U.S.C. 103(a) for obviousness based upon Martin in view of Prompt and in view of Whitehurst and further in view of Haimowitz.

Applicant argues "Haimowitz cannot correct the deficiencies of the Martin, Prompt and Whitehurst reference and therefore the examiner's rejection under 35 U.S.C 103 fails to comply with 37 C.F.R. 1.104(C). Thus, as it will be clear to the Honorable Board, Martin, Prompt, Whitehurst and Haimowitz fail as reference to sufficiently establish a prima facie case of obviousness.

The examiner respectfully disagrees with the above argument. Haimowitz discloses as corresponding to if the pending record is actually a new record, then the data is entered into a new record in the existing records database 12. If there is a match with one or more records, then the user can mark the records and can select

which one will get the updated information (col. 10, lines 14-18). Clearly, this suggests the concept regenerating the matching process for all of the new records.

The rejection of claims 7, 16 and 24 under 35 U.S.C 103(a) for obviousness based upon Martin in view of Prompt and in view of Whitehurst and further in view of Doyle.

Applicant argues "Doyle fails to teach or even mention a "learning progress" or "LMS" or "user information" or "course information" or an "e-learning model". Accordingly, Doyle cannot correct the deficiencies of the Martin, Prompt, Whitehurst and Haimowitz references and therefore the examiner's rejection under 35 U.S.C 103 fails to comply with 37 C.F.R 1.104(C). Thus, as it will be clear to the Honorable Board, Martin, Prompt, Whitehurst, Haimowitz and Doyle fail as references to sufficiently establish a prima facie case of obviousness.

Claims 7, 16 and 24 were rejected under Martin, Prompt, Whitehurst and Doyle and not include Haimowitz. The Haimowitz was inadvertently included in the heading of the rejection. As mentioned in the above argument, Whitehurst discloses a "learning progress" or "LMS" or "user information" or "course information" or an "e-learning model". Furthermore, Doyle discloses "if there is no match, an algorithm 25 save the trial key file as a new permanent key file 26, and tag. ID 9 is set to the ID of the newly created key file. In any case, an algorithm 27 creates a new catalog entry for the recording session" (col. 4, lines 2-5). This suggests the claimed limitation creating a file

containing the unmatched object identifiers having a format similar to the converted user information and course information.

Claim Objections

4. Claims 1, 9 and 17 are objected to because of the following informalities: claim 1 recites "user information and course information" in lines 1-2 which is not the same as "the user and course information" in line 4, claim 9 recites "user information and course information" in lines 2-3 which is not the same as "the user and course information" and claim 17 recites "user information and course information" which is not the same as "the user and course information." Appropriate correction is required.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1, 4-5, 7-8, 17, 20-21 and 23-24 are rejected under 35 U.S.C. 101 because claim 1 recites method transforming the user and course information to the target database. The transformation as recited in claim 1 does not transform the underlying subject matter (such as an article or materials) to a different state or thing. Therefore, claim 1 does not produce concrete, useful and tangible result. Claim 17 recites a data transformation tools for transforming user information and course information comprising: a data transformation utility adapted to convert the user and course information..., a data matching utility adapted to determine if an existing

directory containing object.... and data loading utility adapted to load...which shows data modules to perform the transformation tool. Therefore, the recited transformation tool in claim 17 is program per se or software per se. Software per se is not a series of steps or acts and thus is not a process. Software per se is not a physical article or object and as such is not a machine or manufacture. Software per se is not a combination of substances and therefore is not a composition of matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 4-5, 9, 12-13, 17 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (US. Patent No. 6,016,501) in view of Prompt et al. (US. Patent No. 6,985,905 B2) and further in view of Whitehurst et al. (US. Patent No. 6,978,115 B2).

Regarding on claim 1, Martin teaches a method of transforming a user information and course information from a source database in an e-learning model to a target database in a learning management system, the method comprising:

Converting the source data to a format compatible with the target database, the converted source data containing object identification information (if the source database 104A uses a different database management system than the target database, the transform block may be required to transform the data to the target database format) (col. 9, lines 35-39); and

Loading the converted source data into the target database (the transform block may be required to transform the data to the target database format to enable storage in the database 104B) (col. 9, lines 36-39).

Martin does not explicitly teaches matching object identifiers with corresponding object identifiers related to the object identification information contained in the converted user and course information; and storing the unmatched object identifiers for manual handling and the user information and the course information form a source data in an e-learning model to a target data base in a learning management system. On the other hand, Prompt discloses matching the object identifier with corresponding object identification information contained in the converted source data if there is an

existing directory containing object identifiers related to the object identification information contained in the converted source data (as corresponding to this is contrasted with conventional LDAP directories which require data to be extracted for the authoritative source of the information and transformed into a format matching the LDAP schema of the directory...) (col. 16, lines 55-62). This suggests the concept of matching object of the convert source into the object of LDAP format and obviously the unmatched have to be manually handled and stored. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify martin's system to include the matching the object in the converted source to the object of the LDAP as disclosed in Prompt in order to allow the converted data to be merge into the directory which uses for processing.

Claim 9 is a computer-readable storage medium storing a computer program which when executed performs a method of transforming source data from a source database to a target database in a data management system the method performs the step similar to claim 1; therefore, claim 9 is rejected under the same reason as to claim 1.

Claim 17 is a data transformation system for transforming source data from a source database to a target database in the data management system, the system perform the step similar to claim 1; therefore, claim 17 is rejected under the same reason as to claim 1.

Regarding on claim 4, Martin teaches the method of claim 1, further comprising updating the source database to include the object identifiers contained in the existing directory if a match is found (col. 5, lines 33-38).

Claim 12 recites the same limitation as to claim 4; therefore, claim 12 is rejected under the same reason as to claim 4.

Claim 20 recites the same limitation as to claim 4; therefore, claim 20 is rejected under the same reason as to claim 4.

Regarding to claim 5, Martin discloses the concept of claim 1, wherein the object identification information and the object identifier relate to names of user of the learning management system (the extracted data source are the user names) (col. 9, line 32).

Claim 13 recites the same limitation as to claim 5; therefore, claim 13 is rejected under the same reason as to claim 5.

Claim 21 recites the same limitation as to claim 5; therefore, claim 21 is rejected under the same reason as to claim 5.

7. Claims 8, 15 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (US. Patent No. 6,016,501) in view of Prompt et al. (US. Patent No. 6,985,905 B2) in view of Whitehurst et al. (US. Patent No. 6,978,115 B2) and further in view of Haimowitz et al. (US. Patent No. 5,819,291 B2).

Regarding on claim 8, Martin, Prompt and Whitehurst do not explicitly teach the method of claim 1 further comprising if more than one potential match is found, creating a file containing the potential matches and re-generating the matching process.

However, Haimowitz discloses teach the method of claim 1 further comprising if more than one potential match is found, creating a file containing the potential matches and re-generating the matching process (as corresponding to if the pending record is actually a new record, then the data is entered into a new record in the existing records database 12. If there is a match with one or more records, then the user can mark the records and can select which one will get the updated information) (col. 10, lines 14-18). This suggests he claimed limitation. Therefore, it would have been obvious to one ordinary skill in the art a the time of the invention was made to modify Martin, Prompt and Whitehurst system to include user selection o f one more matching records as disclosed in Haimowitz in order to merge the converted records into the new directory for processing.

Claim 15 recites the same limitation as to claim 8; therefore, claim 15 is rejected under the same reason as to claim 15.

Claim 23 recites the same limitation as to claim 8; therefore, claim 23 is rejected under the same reason as to claim 8.

8. Claims 7, 16 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin et al. (US. Patent No. 6,016,501) in view of Prompt et al. (US. Patent No. 6,985,905 B2) in view of Whitehurst et al. (US. Patent No. 6,978,115 B2) and further in view of Doyle (US. Patent No. 6,058,239).

Regarding on claim 7, Martin, Prompt and Whitehurst disclose the method of claim 1 excepting for wherein storing unmatched object identifiers for manual handling

comprises further creating a file contain the object identifiers having a format similar to the converted source data. On the other hand, Doyle discloses wherein if no match is found, further creating a file contain the object identifiers having a format similar to the converted source data (if there is no match, an algorithm 25 save the trial key file as a new permanent key file 26, and tag. ID 9 is set to the ID of the newly created key file. In any case, an algorithm 27 creates a new catalog entry for the recording session (col. 4, lines 2-5). This suggests the claimed limitation. Therefore, it would have been obvious to one ordinary skill in the art at the time of the invention was made to modify Martin, Prompt and Whitehurst to include creating a new file for the converted data as disclosed by Doyle to allow the data to store in the new system for later processing.

Claim 16 recites the same limitation as to claim 7; therefore, claim 16 is rejected under the same reason as to claim 7.

Claim 24 recites the same limitation as to claim 8; therefore, claim 24 is rejected under the same reason as to claim 8.

Contact Information

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Baoquoc N. To whose telephone number is at 571-272-4041 or via e-mail BaoquocN.To@uspto.gov. The examiner can normally be reached on Monday-Friday: 8:00 AM – 4:30 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached at 571-272-4107.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:
Commissioner of Patents and Trademarks
Washington, D.C. 20231.

The fax numbers for the organization where this application or proceeding is assigned are as follow:

(571) –273-8300 [Official Communication]

/Baoquoc N To/

Primary Examiner, Art Unit 2162